

REMARKS

In response to the final Office Action dated April 5, 2005, Applicant cancels claims 10, 65, 120, and 167-172, without prejudice or disclaimer, amends claims 1, 57, and 111, and adds new claims 176-178. Support for the claim amendments and new claims can be found in the originally-filed specification, claims, and drawings. No new matter has been entered.

Prior to entry of this Amendment, claims 1-36, 38-91, 93-146, and 148-175 were pending. After entry of this Amendment, claims 1-9, 11-36, 38-64, 66-91, 93-119, 121-146, 148-166, and 173-178 will be pending. Of the pending claims, claims 1, 7, 36, 45, 57, 62, 91, 99, 111, 117, 146, 155, and 173-175 are independent.

Applicant appreciates the Examiner's indication that claims 7-9, 12, 27, 36, 45-56, 62-64, 67, 82, 91, 99-110, 117-119, 122, 137, 146, and 155-166 include allowable subject matter.

In the Office Action, claims 1-6, 11, 13-26, 28-35, 38-44, 57-61, 66, 68-81, 83-90, 93-98, 111-116, 121, 123-136, 138-145, 148-154, and 173-175 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,158,913 to Dumler et al. ("Dumler"). Of the claims rejected based on Dumler, claims 1, 57, 111, and 173-175 are independent.

Focusing first on independent claims 1, 57, and 111, each of those claims, as amended, recites a device "configured so that the application element cannot be placed in the reservoir." Dumler does not disclose such a device.

With reference to Figs. 1-3, Dumler discloses a mascara unit 1 having a reservoir 2 with a bottom 3, a neck 5 opposite the bottom, and an interior space 4.

Dumler explicitly discloses that the interior space 4 of the reservoir 2 is “for the take-up of mascara.” (Col. 2, lines 24-28.) The Office Action at page 2 cites a mascara brush 7 of Dumler for the asserted disclosure of an application element. Rather than disclosing a device “configured so that the application element cannot be placed in the reservoir,” as recited in amended claims 1, 57, and 111, Dumler discloses that the mascara brush 7 is dipped into the interior space 4, as shown in Fig. 1, and then swung out into the position of Fig. 3 for application. (Col. 2, lines 29-33 and 44-50.) Since the mascara brush 7 of Dumler dips into the interior space 4, Dumler fails to disclose a device “configured so that the application element cannot be placed in the reservoir,” as recited in amended claims 1, 57, and 111. For at least this reason, the Section 102(e) rejection of independent claims 1, 57, and 111 based on Dumler should be withdrawn. Since claims 2-6, 11, 13-26, 28-35, 38-44, 58-61, 66, 68-81, 83-90, 93-98, 112-116, 121, 123-136, 138-145, and 148-154 depend from one of independent claims 1, 57, and 111, the Section 102(e) rejection of those claims should be withdrawn for at least the same reasons as the respective independent claims.

Turning now to claims 173-175, Applicant respectfully submits that the Section 102(e) rejection of those claims should be withdrawn because Dumler does not disclose a device “configured to load at least a portion of the application element with product from the reservoir while the application element is positioned in the cavity,” as recited in each of claims 173-175. The final Office Action cites the interior space 4 of Dumler for the asserted disclosure of a reservoir and, as mentioned above, cites Dumler’s mascara brush 7 for the asserted disclosure of an application element. The final Office Action also asserts that “when the application element is in the cavity as shown in figure 2,

product from the reservoir may flow into the cavity and onto the applicator.” (Final Office Action at 4.)

Contrary to assertions in the final Office Action, product cannot flow from the interior space 4 when the mascara brush 7 is positioned as shown in Fig. 2, because Dumler discloses “a slit elastic membrane 18 **closing** an aperture 19 of the reservoir 2” Col. 2, lines 56-57 (emphasis supplied). Since Dumler describes the slit elastic member as “closing” the aperture 19 of reservoir 2, Dumler specifically discloses **preventing flow** of product from the reservoir 2 and its interior space 4 when the mascara brush 7 is positioned as shown in Fig. 2. Furthermore, Dumler does not disclose a configuration that enables any portion of the mascara brush 7 to become loaded with product from the interior space 4 while the mascara brush 7 is positioned outside of interior space 4, for example, in the position shown in Fig. 2. Thus, Dumler fails to disclose or otherwise suggest a device “configured to load at least a portion of the application element with product from the reservoir while the application element is positioned in the cavity,” as recited in each of claims 173-175. For at least this reason, the Section 102(e) rejection of claims 173-175 should be withdrawn.

In the final Office Action, claims 10, 65, 120, and 167-172 were rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 5,348,031 to Cloud in view of U.S. Patent No. 6,450,720 to Cai.¹ Although Applicant respectfully disagrees with this ground of

¹ Applicants do not know for certain whether claims 167-172 have been rejected under 35 U.S.C. § 103(a). Those claims are not mentioned in the rejection statement appearing in the final Office Action at page 3, but they are mentioned in the sentence bridging pages 3 and 4 of the final Office Action, which apparently relates to the Section 103(a) claim rejection. If claims 167-172 are not rejected under 35 U.S.C. § 103(a), Applicant respectfully requests that the Examiner provide an indication of the status of those claims in the next written communication issued by the Examiner.

rejection, Applicant has canceled claims 10, 65, 120, and 167-172 without prejudice or disclaimer, to advance prosecution.

Applicant submits that independent claims 1, 7, 36, 45, 57, 62, 91, 99, 111, 117, 146, 155, and 173-175 are allowable and that any dependent claims which depend from those claims also are allowable for at least the same reasons each respective independent claim is allowable.

The present Amendment After Final does not raise any new issues requiring any further consideration and/or search. For example, the language added to claims 1, 57, and 111 is closely related to the language added to those claims in the Amendment filed on January 13, 2005, and thus, amended claims 1, 57, and 111 should not necessitate any detailed consideration or search by the Examiner. Furthermore, new claims 176-178 are dependent claims that should be allowable for at least the same reasons the claims from which they depend are allowable. Consequently, this Amendment After Final should be entered because it places the present application in condition for allowance. Alternatively, this Amendment After Final should be entered at least for purposes of appeal.

Applicant respectfully requests entry of the present amendment, withdrawal of the outstanding claim rejections, and the allowance of pending claims 1-9, 11-36, 38-64, 66-91, 93-119, 121-146, 148-166, and 173-178.

The final Office Action contains characterizations and assertions, including characterizations and/or assertions regarding the cited art and Applicant's claims, with which Applicant does not necessarily agree. Unless explicitly noted otherwise herein,


Applicant declines to subscribe to any such characterizations and/or assertions set forth in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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